

Appl. No. 10/034,296
Amdt. dated October 13, 2004
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group

PATENT

REMARKS/ARGUMENTS

Claims 1-18 have been canceled without prejudice for re-presentation in a subsequent continuing application.

Claims 19 and 38 have been revised to use alternative language for the identical concept of the claimed subject matter being distinct from aerogels that are formed by joining together of aerogel particles or granules in a binder. Specifically, the claims now more expressly recite that it is a monolith composite of aerogel that is encompassed. Support for the revised language is present throughout the application and claims as originally filed.

Claims 19, 44, and 45 have also been revised to correct language informalities.

Claims 34 and 36 have been revised to use alternative language for the identical concept of the composite of the invention "in combination with" additional elements. No narrowing of claim scope is intended or believed to have occurred.

No new matter has been introduced, and entry of the amendments is respectfully requested.

Preliminary Remarks

Claims 1-18 have been canceled such that only claims 19-48 remain pending. Applicants note that none of claims 19-48 were indicated as being within the scope of rejections alleging anticipation and obviousness in light of Ramamurthi. Accordingly, Applicants believe that claims 19-48 are free of the prior art and respectfully request early indication to that effect.

Information Disclosure Statement

An Information Disclosure Statement citing only the five patents discussed on pages 3-4 of the instant application (paragraphs 0006 to 0009 on pages 1-2 of the published version of the instant application) has been submitted with this response. Applicants respectfully submit their belief that these documents were already considered by the Examiner during previous examination of the instant application and so an indication to this effect by initialing

Appl. No. 10/034,296
Amdt. dated October 13, 2004
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group

PATENT

and returning the attached PTO/SB/08A (substitute for Form PTO-1449) would pose no undue burden on the Examiner.

Applicants express their gratitude in advance to the Examiner for her courtesy in assisting Applicants with making these references formally of record in the instant application.

Claim Objections

Claims 19 and 44-45 (rather than 45-46 as indicated) were objected to due to the presence of unnecessary hyphens in the claims. This informality has been addressed by the above amendments, and the objection may be withdrawn.

Rejections under 35 U.S.C. § 112, first paragraph

Claims 1, 12, 19 and 38 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement due to the use of the phrase "the aerogel monolith is not formed by a joining together of aerogel particles or granules in a binder." The statement of the rejection alleged that this phrase is "new matter" and a "negative limitation".

Applicants have carefully reviewed the statement of the rejection and respectfully submit that it has been obviated by the above amendments to the claims and without acquiescence to the positions set forth in the rejection.

In particular, claims 1 and 12 have been canceled, and claims 19 and 38 have been revised to capture the same concept of an aerogel monolith that is a composite comprising a lofty fibrous batting and other fibers as recited in the claims. As indicated by Ramamurthi et al. (USP 5,306,555 as cited in the "final" Office Action), there are two forms of aerogel materials beyond "conventional aerogels". As shown at the bottom of the front page of Ramamurthi et al., the two forms are "aerogel matrix composites" (which are produced as an aerogel monolith) and "aerogel powder-fiber compacts" (which are produced by compacting powders with fibers in the presence of a binder). The phrase objected to in claims 19 and 38 was directed to exclusion of the latter, "aerogel powder-fiber compact" form.

Appl. No. 10/034,296
Amdt. dated October 13, 2004
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group

PATENT

Both claims 19 and 38 have now been revised to be directed to the first, "aerogel matrix (or monolith) composite" form without altering the scope of the claims and thus without introducing the need for additional search or consideration.

In light of the above, Applicants respectfully submit that this rejection has been rendered moot, and may be properly withdrawn.

Rejections under 35 U.S.C. § 112, second paragraph

Claims 34 and 36 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite because "it is unclear whether the heat sink and the device which converts the thermal energy to electrical energy are being claimed and a part of the system." The statement of the rejection further alleges that the phrase "in combination with" was in the "preamble" of the claims

Applicants have carefully reviewed the statement of the rejection and respectfully submit that no *prima facie* case of indefiniteness has been presented. As an initial matter, the phrase "in combination with" is not in the preamble of the claim because it is the transitional phrase going from the preamble to the body of each of claims 34 and 36. As established in U.S. patent practice, the range of transitional phrases are not limited to "comprising", "consisting of", and "consisting essentially of", but is significantly broader such that phrases like "having", "including", and "containing" are also possible.

In the instant case, Applicants previous representative chose to use "in combination with" as the transitional phrase. Accordingly, no *prima facie* case of indefiniteness is present in claims 34 and 36 as previously presented.

In light of the instant rejection, however, Applicants have revised the phrase to be "comprising" without narrowing the scope of the claims, which has always encompassed the presence of the "heat sink" and "device" as recited in the claims.

Given the above, Applicants believe that this rejection was misplace and could have been withdrawn without revisions of claims 34 and 36. In light of the revisions, the rejection has definitely been obviated, and Applicants respectfully request its withdrawal.

Appl. No. 10/034,296
Amdt. dated October 13, 2004
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group

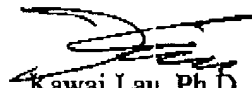
PATENT

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 858-350-6151 .

Respectfully submitted,


Kawai Lau, Ph.D.
Reg. No. 44,461

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 858-350-6100
Fax: 415-576-0300
Attachments
KL:ps
60332095 v1

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) 872-9306 on October 13, 2004.

OCT 13 2004 **PATENT**
Attorney Docket No.: 022024-000300US

TOWNSEND and TOWNSEND and CREW LLP

By: *Samuel Skelton*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Christopher J. Stepanian, et al.

Application No.: 10/034,296

Filed: December 21, 2001

For: AEROGEL COMPOSITE WITH
FIBROUS BATTING

Examiner: Jennifer A. Boyd

Art Unit: 1771

INFORMATION DISCLOSURE
STATEMENT UNDER 37 CFR §1.97 and
§1.98

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The references cited on attached form PTO/SB/08A are being called to the attention of the Examiner. Copies of the cited U.S. patent references are not enclosed. It is respectfully submitted that these five patents, discussed on pages 3-4 of the instant application (paragraphs 0006 to 0009 on pages 1-2 of the published version of the instant application) were already considered by the Examiner during previous examination of the instant application.

Applicants express their gratitude in advance for these references officially being made of record in this application to appear among the "references cited" on any patent to issue therefrom.

As provided for by 37 CFR 1.97(g) and (h), no inference should be made that the information and references cited are prior art merely because they are in this statement and no

Christopher J. Stepanian, et al.
Application No.: 10/034,296
Page 2

PATENT

representation is being made that a search has been conducted or that this statement encompasses all the possible relevant information.

Applicant believes that no fee is required for submission of this statement.

However, if a fee is required, the Commissioner is authorized to deduct such fee from the undersigned's Deposit Account No. 20-1430. Please deduct any additional fees from, or credit any overpayment to, the above-noted Deposit Account.

Respectfully submitted,



Kawai Lau, Ph.D.
Reg. No. 44,461

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 858-350-6100
Fax: 415-576-0300
KL:tsp
60332128 v1